

Patent and Trademark Offic

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APPLICATION NO.	FILING DATE	FIRST NAMED	INVENTOR		ATTORNEY DOCKET NO.	
09/363,100	07/29/99	MICKLE		<u>[</u>]	50074/004003	
		HM12/0710	\neg	EXAMINER		
KRISTINA BIEKER-BRADY AT CLARK & ELBING				AFREMOVA,V		
176 FEDERAL STREET				ART UNIT	PAPER NUMBER	
BOSTON MA 0	2110	• •		1651	<u>5</u>	
				DATE MAILED:	07/10/00	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Application No. 09/363,100 Applicant(s)

Mickle et al.

Office Action Summary			
Office Action Summary	Examiner Vera Afremova	Group Art Unit 1651	
Responsive to communication(s) filed on Jan 24, 20	00		·
This action is FINAL.	,		
Since this application is in condition for allowance ex in accordance with the practice under Ex parte Quay	de, 1935 C.D. 11; 453 O.G. 21	3.	
shortened statutory period for response to this action longer, from the mailing date of this communication. pplication to become abandoned. (35 U.S.C. § 133). 7 CFR 1.136(a).	Failure to respond within the pe	eriod for response t	will cause the
Disposition of Claims			
X Claim(s) 1-24	is/	are pending in the	application.
Of the above, claim(s)	is/ar	e withdrawn from	consideration.
Claim(s)			
Claim(s)			
Claim(s)			to.
 ☐ The drawing(s) filed on is/a ☐ The proposed drawing correction, filed on ☐ The specification is objected to by the Examiner. ☐ The oath or declaration is objected to by the Examiner. 	isapproved		
Priority under 35 U.S.C. § 119 Acknowledgement is made of a claim for foreign	n priority under 35 U.S.C. § 119	(a)-(d).	
☐ All ☐ Some* ☐ None of the CERTIFIED			
received.			
received in Application No. (Series Code/S	Serial Number)	·	
received in this national stage application	from the International Bureau (P	CT Rule 17.2(a)).	
*Certified copies not received:			•
Acknowledgement is made of a claim for domes	stic priority under 35 U.S.C. § 1	19(e).	
Attachment(s)			
X Notice of References Cited, PTO-892			
 Information Disclosure Statement(s), PTO-1449, 	, Paper No(s).		
☐ Interview Summary, PTO-413	DTO 040		
 Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review Notice of Informal Patent Application, PTO-152 	v, PTO-948		

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claims 1-24 are pending and subject to restriction requirement.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a method for treating myocardial tissue by administering a composition with mesenchymal stem cells, classified in class 424, subclass 9.1+, for example.
- II. Claims 14-21, drawn to a method for obtaining a composition with cardiomyogenic cells, classified in class 435, subclass 325+, for example.
- III. Claims 22-24, drawn to a composition with mesenchymal stem cells, classified in class 424, subclass 93.7, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case a composition with mesenchymal stem cells as claimed can be used as a research reagent, for diagnostic and for therapeutic purposes as a composition with pluripotent cells capable to differentiate into several different cell lines including osteocytes, chrondocytes,

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apidocytes, etc. which can be applied to enhance or stimulate in vivo regeneration and/or repair of different connective tissue areas (see US 5,486,359 abstract, col. 5, lines 36-40, 55-60).

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a composition with mesenchymal stem cells as claimed can be made by selective separation based upon cell adherence through specific protein binding sites (see US 5,486,359 col.7, lines 40-45).

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR1.17(I).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (703) 308-9351. The examiner can normally be reached on Monday to Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196

Vera Afremova,

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July 6, 2000.

SANDRA E. SAUCIER **PRIMARY EXAMINER**